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APPLICATION NO.	FILING DATE	NAME OF APPLICANT	ATTORNEY DOCKET NO.
07/578,942	09/07/90	CALATAYUD J	RCS-2-001

EXAMINER
GRUMBLING, M

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ART UNIT: 122 PAPER NUMBER: 4

DATE MAILED: 04/02/91

☑ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire — month(s), 30 days from the date of this letter. for restriction only
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☑ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice re Patent Drawing, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, Form PTO-152
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____.

Part II SUMMARY OF ACTION

1. ☑ Claims 1-16 are pending in the application.

   Of the above, claims _____ are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☐ Claims _____ are rejected.
5. ☐ Claims _____ are objected to.
6. ☑ Claims 1-16 are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____. has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____ ; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-3 and 13-16, drawn to steroid compounds, pharmaceutical compositions thereof and therapeutic methods of use employing the same, classified in Classes 540 subclasses 70 and 63 and class 514, subclass 174.

II. Claims 4-11, drawn to a process of making steroids, classified in Class 540 subclass 63 and class 540, subclass 70.

III. Claim 12, drawn to steroid intermediates, classified in Classes 552 subclass 565 and class 552, subclass 566.

Inventions III and I are related as mutually exclusive species in intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (M.P.E.P. § 806.04(b), 3rd paragraph), and the species are patentably distinct (M.P.E.P. § 806.04(h)).

In the instant case, the intermediate product is deemed to be useful as intermediates in making antiallergic compounds and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case.

In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (M.P.E.P. § 806.05(f)). In the instant case the product as claimed could be made by a materially different process such as reaction of the 16,17-dihydroxy pregnene dione with an aldehyde as taught by Thalen et al. in US 4,404,200.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art due to their recognized divergent subject matter restriction for examination purposes as indicated is proper.

A telephone call was made to Mr. Richard Minnich on 21 March 1991 to request an oral election to the above restriction requirement, but did not result in an election being made.

Because of the applicants' unfamiliarity with United States Patent Office restriction practice, Mr. Minnich required the extra time and clarity of a written restriction requirement in order to better explain its purpose and implications to his clients.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew V. Grumbling whose telephone number is (703) 308-1257.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

Mukund J. Shah

MUKUND J. SHAH
SUPERVISORY PATENT EXAMINER
GROUP 120 - ART UNIT 122

Grumbling:st
March 26, 1991
March 29, 1991

MVG